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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/830,182	04/22/2004	Andrea F. Gulla	426.008A	7722
47888	7590	12/20/2007	EXAMINER	
HEDMAN & COSTIGAN P.C. 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036			HAILEY, PATRICIA L	
			ART UNIT	PAPER NUMBER
			1793	
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			12/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/830,182	GULLA ET AL.	
	Examiner	Art Unit	
	Patricia L. Hailey	1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-7,10,12-22 and 36-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 41-45 is/are allowed.
- 6) ☐ Claim(s) 1,3,5-7,10,12-22,36-40 and 46-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicants' remarks and amendments, filed on September 24, 2007, have been carefully considered. No claims have been canceled or added; claims 1, 3, 5-7, 10, 12-22, and 36-48 remain pending in this application.

Withdrawn Objections

The objection to claim 45 stated in the previous Office Action has been withdrawn in view of Applicants' amendment to this claim.

Maintained Rejections

The following rejections of record have been maintained; the text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

1. Claims 1, 3, 5-7, 10, 12, 13, 15-19, and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forquy et al. (U. S. Patent No. 5,166,362) in view of Lang et al. (U. S. Patent No. 5,051,389) and Ito et al. (U. S. Patent No. 6,649,300).

Forquy et al. disclose a catalyst comprising ruthenium sulphide in either bulk or supported form, as well as a mixture of sulphides of ruthenium and at least one other transition metal selected from the group consisting of, inter alia, cobalt, wherein the proportion of metal other than ruthenium in the mixture is "up to 80 by weight". See col.

2, lines 22-38 of Forquy et al., which, at lines 27-30, also discloses active carbon as an exemplary support.

For the preparation of supported catalysts, the support is impregnated with one or more metal salts (for example, chlorides), followed by direct sulphurization with a mixture of hydrogen and H₂S (2 to 50% by volume, preferably approximately 15%), or with H₂S diluted in an inert gas (for example, nitrogen) at a temperature between 300°C and 700°C. These temperature treatments are preferably carried out in the reactor. See col. 2, lines 52-66 of Forquy et al. (considered to read upon **claims 5, 12, 13, 16, 17, and 47**).

Example 2 of Forquy et al. depicts drying of an exemplary catalyst precursor at temperature between 100°C and 200°C, followed by sulphurization at 400°C for 4 hours. See col. 4, lines 35-39 of Forquy et al. (considered to read upon **claims 15, 18, 19, and 48**).

Because this reference discloses a mixed sulfide supported on carbon, as recited in the instant claims, the catalyst of Forquy et al. would be expected by one of ordinary skill in the art to function as an "electrocatalyst for oxygen reduction", absent the showing of convincing evidence to the contrary.

Forquy et al. do not explicitly disclose "carbon black" as the support, nor does this reference disclose a surface area for said support.

Lang et al. disclose catalysts prepared by depositing a metal or metal compound onto a preformed carbon support and thereafter converting the metal or metal compound to an oxide or sulfide. Exemplary metals include cobalt and ruthenium;

suitable carbons include carbon black. See col. 3, lines 3-19 and col. 4, lines 19 and 20 of Lang et al.

Because Forquy et al. and Lang et al. disclose catalyst compositions having similar components, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of Forquy et al. by substituting carbon black for active carbon, as both carbon black and active carbon are known catalyst supports.

Ito et al. at col. 3, lines 49-65 disclose that conductive carbons (e.g., furnace and acetylene blacks—considered equivalent to “carbon black”) can exhibit a BET surface area of 240 m²/g.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of Forquy et al. by employing conductive carbons such as that disclosed by Ito et al. and thereby obtain Applicants’ invention.

As claims 6 and 12, in their present form, are product-by-process claims (“obtained by...”), it has been held that... “[A]ny difference imparted by the product by process limitations would have been obvious to one having ordinary skill in the art at the time the invention was made because where the examiner has found a substantially similar product as in the applied prior art the burden of proof is shifted to the applicant to establish that their product is patentably distinct, not the examiner to show that the same is a process of making.” In re Brown, 173 U.S.P.Q. 685 and In re Fessmann, 180 U.S.P.Q. 324.

2. Claims 20-22 and 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Methanol Tolerant Oxygen Reduction Catalysts Based on Transition Metal Sulfides”, by R. W. Reeve et al., in view of Forquy et al. (U. S. Patent No. 5,166,362), Lang et al. (U. S. Patent No. 5,051,389), and Ito et al. (U. S. Patent No. 6,649,300).

The Reeve et al. article discloses carbon-supported transition metal sulfide electrocatalysts such as $\text{Mo}_x\text{Ru}_y\text{S}_z$. See page 3463 of the article, under the heading “Experimental”.

The article also discloses gas diffusion electrodes prepared by applying catalyzed carbons to Teflonized carbon paper substrates using Nafion (**claims 20-22 and 36-40**). See page 3464 of the Reeve et al. article, the paragraph entitled “Electrode manufacture”.

Forquy et al., Lang et al., and Ito et al. are relied upon for their teachings as stated in the above 103(a) rejection. Although these references teach catalysts reading upon Applicants’ electrocatalyst as recited in claims 1, 5-7, 10, 12, 13, 15-19, and 46-48, these references do not teach or suggest the limitations of claims 20-22 and 36-40.

However, Forquy et al. disclose, in addition to cobalt, molybdenum as an exemplary transition metal suitable for constituting Patentees’ “mixture of sulphides of ruthenium and at least one other transition metal” (col. 2, lines 31-38).

Therefore, because these were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to

substitute cobalt for molybdenum, given the equivalence between molybdenum and cobalt in preparing a catalytic mixture of metal sulfides, as set forth in Forquy et al., and thereby obtain Applicants' claimed invention as recited in claims 20-22 and 36-40.

3. Claims 1, 3, 5-7, 12, 14-19, 47, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobylinski et al. (U. S. Patent No. 3,840,389) in view of Forquy et al. (U. S. Patent No. 5,166,362).

Kobylinski et al. disclose catalyst prepared by coating a support (such as refractory oxides, or activated carbon, said support exhibiting a surface area from about 10 m²/g to about 500 m²/g; see paragraph 5) with a metal sulfide selected from the group consisting of (1) the sulfides of ruthenium and/or rhodium and (2) the sulfides of ruthenium and/or rhodium in combination with one or more of the sulfides of platinum, palladium, osmium, or iridium, and the product resulting therefrom. See paragraph 1 of Kobylinski et al. (considered to read upon **claims 5-8**).

The catalysts are prepared by impregnating the support with a solution, aqueous or alcoholic, containing a dissolved salt of the aforementioned metals. Suitable salts include chlorides and nitrates; when an alcoholic solution is employed, any suitable alcohol (e.g., propanol) is satisfactory. Suitable impregnation can be obtained over a period ranging from about 15 minutes to about 6 hours; the temperature of treatment ranges from about 15° to about 95°C. Pressure is not critical (considered to read upon the limitations of **claim 15**) but generally atmospheric pressure will suffice. See paragraph 6 of Kobylinski et al.

The impregnated support is then treated with H_2S to precipitate the corresponding metal sulfide under conditions similar to those employed for impregnation. The impregnated support may also, if wet with water or alcohol after treatment with H_2S , may be dried at temperatures ranging from about $80^{\circ}C$ to about $180^{\circ}C$. Drying can be effected in air, an inert atmosphere (such as nitrogen or H_2S). Further, the catalyst is preferably subjected to calcinations at temperatures ranging from about $400^{\circ}C$ to about $600^{\circ}C$; as in the drying step, calcination can be effected in air, an inert gas such as nitrogen, or even H_2S . See paragraph 8 of Kobylinski et al. (**claims 11, 14, 16-19, 47, and 48**).

Kobylinski et al. do not explicitly disclose that the catalyst is an "electrocatalyst", or that the support is "conductive". However, because the reference teaches the same components as recited in Applicants' claims as the "electrocatalyst" and the "conductive" support, it would have been obvious to one of ordinary skill in the art at the time the invention was made to reasonably expect that the catalysts of Kobylinski et al. would function as an "electrocatalyst", absent the showing of convincing evidence to the contrary.

It is well settled that when a claimed composition appears to be substantially the same as a composition disclosed in the prior art, the burden is properly upon the applicant to prove by way of tangible evidence that the prior art composition does not necessarily possess characteristics attributed to the CLAIMED composition. In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Circ. 1990); In re Fitzgerald, 619 F.2d 67,

205 USPQ 594 (CCPA 1980); In re Swinehart, 439 F.2d 2109, 169 USPQ 226 (CCPA 1971).

Kobylinski et al. also do not disclose a mixed sulfide of ruthenium and cobalt, as instantly claimed.

Forquy et al. disclose a catalyst comprising ruthenium sulphide in either bulk or supported form, as well as a mixture of sulphides of ruthenium and at least one other transition metal selected from the group consisting of, inter alia, cobalt, wherein the proportion of metal other than ruthenium in the mixture is "up to 80 by weight". See col. 2, lines 22-38 of Forquy et al., which, at lines 27-30, also discloses active carbon as an exemplary support. Note that rhodium and palladium are also disclosed in Kobylinski et al.

For the preparation of supported catalysts, the support is impregnated with one or more metal salts (for example, chlorides), followed by direct sulphurization with a mixture of hydrogen and H₂S (2 to 50% by volume, preferably approximately 15%), or with H₂S diluted in an inert gas (for example, nitrogen) at a temperature between 300°C and 700°C.

In view of the similarities between Kobylinski et al. and Forquy et al., it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of Kobylinski et al. by substituting cobalt for either rhodium or palladium, as suggested by Forquy et al., and thereby obtain Applicants' claimed invention.

Response to Arguments

In response to Applicants' arguments that the cited references fail to teach or suggest an electrocatalyst as claimed, it is the Examiner's position that the cited references are relevant to the claimed invention because they are considered to structurally read upon Applicants' claims, as these references disclose catalyst components that read upon that instantly claimed.

In response to Applicants' arguments regarding the 132 Declaration, "which the Examiner failed to comment on...", said Declaration was submitted subsequent to the Final Rejection, i.e., at a time where consideration of the Declaration was not required.

In any event, the Declaration merely states that activated carbon and carbon black are different substances. While this is true, they are both known in the art as catalyst supports (as set forth in the rejections of record), and are therefore art-recognized equivalents. Substitution of one for the other is well within the level of ordinary skill in the art.

For these reasons, Applicants' arguments are not persuasive, and the rejections of record are maintained.

Allowable Subject Matter

4. Claims 41-45 are allowed.
5. The following is a statement of reasons for the indication of allowable subject matter:

The prior art cited does not teach or suggest the step of sintering in a hydrogen atmosphere, followed by subsequent heating under an inert atmosphere.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Hailey whose telephone number is (571) 272-1369. The examiner can normally be reached on Mondays-Fridays, from 7:00 a.m. to 3:30 p.m.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:
10/830,182
Art Unit: 1793

Page 11

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 1700 Receptionist, whose telephone number is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Patricia L. Hailey/plh
Examiner, Art Unit 1793
December 18, 2007


J.A. LORENZO
SUPERVISORY PATENT EXAMINER